

Art. 82

Since unity of invention under Art. 82 is only required for the European patent application, the unity of the subject-matter of the European patent may not be examined by the Opposition Division, even of its own motion. In particular, where the facts, evidence and arguments which come to light in the opposition proceedings lead to the maintenance of the European patent in amended form, there should be no further examination as to whether the remaining subject-matter of the patent contains a single invention or more than one. Any lack of unity must be accepted (see G 1/91, OJ 6/1992, 253).

The grounds for opposition laid down in Art. 100 are examined in greater detail below.

### 3. Non-patentability pursuant to Art. 52 to 57

Art. 100(a)

The same substantive requirements apply in the opposition procedure regarding patentability pursuant to Art. 52 to 57 as in the examination procedure. Part C, Chapter IV, should therefore also be applied in opposition proceedings. However, it will be more common in opposition proceedings than in examination procedure for the examination as to patentability to be based on the state of the art as made available to the public not by written description but "by means of an oral description, by use, or in any other way" (see Art. 54(2)). The above-mentioned ways in which the state of the art may be made available to the public will accordingly be considered in more detail below.

#### 3.1 State of the art made available to the public "by use or in any other way"

##### 3.1.1 Types of use and instances of state of the art made available in any other way

Use may be constituted by producing, offering, marketing or otherwise exploiting a product, or by offering or marketing a process or its application or by applying the process. Marketing may be effected, for example, by sale or exchange.

The state of the art may also be made available to the public in other ways, as for example by demonstrating an object or process in specialist training courses or on television.

Availability to the public in any other way also includes all possibilities which technological progress may subsequently offer of making available the aspect of the state of the art concerned.

##### 3.1.2 Matters to be determined by the Opposition Division as regards use

When dealing with an allegation that an object or process has been used in such a way that it is comprised in the state of the art, the Opposition Division will have to determine the following details:

- (i) the date on which the alleged use occurred, i.e. whether there was any instance of use before the relevant date (prior use);
- (ii) what has been used, in order to determine the degree of similarity between the object used and the subject-matter of the European patent; and
- (iii) all the circumstances relating to the use, in order to determine whether and to what extent it was made available to the public, as for example the place of use and the form of use. These factors are important in that, for example, the details of a demonstration of a manufacturing process in a factory or of the delivery and sale of a product may well provide information as regards the possibility of the subject-matter having become available to the public.

On the basis of the submissions and the evidence already submitted, e.g. documents confirming sale, or affidavits related to the prior use, the Opposition Division will first establish the relevance of the alleged prior use. If on the basis of this assessment it is of the opinion that the prior use is sufficiently substantiated and relevant, it may decide on the opposition using the submissions and the evidence, if the patentee does not contest the prior use. If the patentee does contest it or certain circumstances of it, the Division will need to take further evidence, if offered (e.g. hearing witnesses or performing an inspection) for those facts which are relevant to the case and which cannot yet be considered proven on the basis of the evidence already submitted. Evidence is always taken under participation of the parties, normally in oral proceedings. For details concerning means of evidence see E-IV, 1.2.

### 3.1.3 Ways in which subject-matter may be made available

#### 3.1.3.1 General principles

Subject-matter should be regarded as made available to the public by use or in any other way if, at the relevant date, it was possible for members of the public to gain knowledge of the subject-matter and there was no bar of confidentiality restricting the use or dissemination of such knowledge (see also C-IV, 5.1 with reference to written descriptions). This may, for example, arise if an object is unconditionally sold to a member of the public, since the buyer thereby acquires unlimited possession of any knowledge which may be obtained from the object. Even where in such cases the specific features of the object may not be ascertained from an external examination, but only by further analysis, those features are nevertheless to be considered as having been made available to the public. This is irrespective of whether or not particular reasons can be identified for analysing the composition or internal structure of the object. These specific features only relate to the intrinsic features. Extrinsic characteristics, which are only revealed when the product is exposed to interaction with specifically chosen outside conditions, e.g. reactants or the like, in order to provide a particular effect or result or to discover potential results or capabilities, therefore point beyond the product per se as they are dependent on deliberate choices being made. Typical examples are the application as a pharmaceutical product of a known substance or composition (cf. Art. 54(5)) and the use of a known compound for a particular purpose, based on a new technical effect (cf. G 2/88, OJ 4/1990, 93). Thus, such characteristics cannot be considered as already having been made available to the public (see G 1/92, OJ 5/1993, 277).

If, on the other hand, an object could be seen in a given place (a factory, for example) to which members of the public not bound to secrecy, including persons with sufficient technical knowledge to ascertain the specific features of the object, had access, all knowledge which an expert was able to gain from a purely external examination is to be regarded as having been made available to the public. In such cases, however, all concealed features which could be ascertained only by dismantling or destroying the object will not be deemed to have been made available to the public.

#### 3.1.3.2 Agreement on secrecy

The basic principle to be adopted is that subject-matter has not been made available to the public by use or in any other way if there is an express or tacit agreement on secrecy which has not been broken (reference should be made to the particular case of a non-prejudicial disclosure arising from an evident abuse in relation to the applicant, in accordance with Art. 55(1)(a)), or if the circumstances of the case are such that such secrecy derives from a relationship of good faith or trust. Good faith and trust are factors which may occur in contractual or commercial relationships.

### 3.1.3.3 Use on non-public property

As a general rule, use on non-public property, for example in factories and barracks, is not considered as use made available to the public, because company employees and soldiers are usually bound to secrecy, save in cases where the objects or processes used are exhibited, explained or shown to the public in such places, or where specialists not bound to secrecy are able to recognise their essential features from the outside. Clearly the above-mentioned "non-public property" does **not** refer to the premises of a third party to whom the object in question was unconditionally sold or the place where the public could see the object in question or ascertain features of it (see the examples in 3.1.3.1 above).

### 3.1.3.4 Example of the accessibility of objects used

A press for producing light building (hard fibre) boards was installed in a factory shed. Although the door bore the notice "Unauthorised persons not admitted", customers (in particular dealers in building materials and clients who were interested in purchasing light building boards) were given the opportunity of seeing the press although no form of demonstration or explanation was given. An obligation to secrecy was not imposed as, according to witnesses, the company did not consider such visitors as a possible source of competition. These visitors were not genuine specialists, i.e. they did not manufacture such boards or presses, but were not entirely laymen either. In view of the simple construction of the press, the essential features of the invention concerned were bound to be evident to anyone observing it. There was therefore a possibility that these customers, and in particular the dealers in building materials, would recognise these essential features of the press and, as they were not bound to secrecy, they would be free to communicate this information to others.

### 3.1.3.5 Example of the inaccessibility of a process

The subject of the patent concerns a process for the manufacture of a product. As proof that this process had been made available to the public by use, a similar already known product was asserted to have been produced by the process claimed. However, it could not be clearly ascertained, even after an exhaustive examination, by which process it had been produced.

## 3.2 State of the art made available by means of oral description

### 3.2.1 Cases of oral description

Art. 54(2)

The state of the art is made available to the public by oral description when facts are unconditionally brought to the knowledge of members of the public in the course of a conversation or a lecture or by means of radio, television or sound reproduction equipment (tapes and records).

### 3.2.2 Non-prejudicial oral description

Art. 55(1)(a)

The state of the art will not be affected by oral descriptions made by and to persons who were bound to, and preserved, secrecy, nor by an oral disclosure which was made no earlier than six months before the filing of the European patent application and which derives directly or indirectly from an evident abuse in relation to the applicant or his legal predecessor. In determining whether evident abuse has occurred, note C-IV, 8.3.

### 3.2.3 Matters to be determined by the Opposition Division in cases of oral description

Once again, in such cases the following details will have to be determined:

- (i) when the oral description took place;
- (ii) what was described orally; and

- (iii) whether the oral description was made available to the public; this will also depend on the type of oral description (conversation, lecture) and on the place at which the description was given (public meeting, factory hall; see also V, 3.1.2(iii)).

### 3.3 State of the art made available to the public in writing or by any other means

For this state of the art, details equivalent to those defined in V, 3.2.3 have to be determined if they are not clear from the written or other disclosure itself or if they are contested by a party.

If information is made available by means of a written description and use or by means of a written and oral description, but only the use or the oral description is made available before the relevant date, then in accordance with C-IV, 5.1, the subsequently published written description may be deemed to give a true account of that oral description or use, unless the proprietor of the patent can give good reason why this should not be the case. In this case, the opponent must adduce proof to the contrary in respect of the reasons given by the proprietor of the patent. Caution should be exercised when considering the type of evidence presented to substantiate the content of an oral description. For example, a report of a lecture written by the lecturer himself may not be an accurate account of what was in fact conveyed to the public. Similarly, a script from which the lecturer purportedly read may not actually have been completely and comprehensibly read (see T 1212/97, not published in OJ).

## 4. Insufficient disclosure of the invention

### 4.1 Required form of disclosure

Determination of whether the disclosure of an invention in a European patent application is sufficient is dealt with in C-II.

Art. 100(b)

The principles set out there will also apply *mutatis mutandis* to the opposition procedure. The overriding consideration in this context is the disclosed content of the European patent specification, that is to say what a person skilled in the art is able to infer from the patent claims, description and drawings, if any, without reflection as to inventiveness. Pursuant to Art. 100(b), the patent has to disclose the invention in a manner sufficiently clear and complete for it to be carried out by persons skilled in the art. If the patent specification does not disclose the invention sufficiently clearly to enable it to be carried out in accordance with Art. 100(b), this may be remedied, provided the original documents contained a sufficient disclosure, but subject to the condition that, as required under Art. 123(2), the subject-matter of the European patent does not extend beyond the content of the application as filed and, as required under Art. 123(3), the protection conferred is not extended.

### 4.2 Disclosure of inventions relating to biological material

Rule 28(1), (2)

The relevant details in this connection can be found in C-II, 6.

### 4.3 Burden of proof as regards the possibility of performing and repeating the invention

If the Opposition Division has serious doubts as regards the possibility of performing the invention and repeating it as described, the burden of proof as regards this possibility, or at least a demonstration that success is credible, rests with the proprietor of the patent. This may be the case where, for example, experiments carried out by the opponent suggest that the subject-matter of the patent does not achieve the desired technical result. As regards the possibility of performing and repeating the invention, see also C-II, 4.11.